

REMARKS

Claims 1-4 were examined and reported in the Office Action. Claims 1-4 are rejected. Claims 1-4 remain.

Applicant requests reconsideration of the application in view of the following remarks.

I. 35 U.S.C. §103

It is asserted in the Office Action that claims 1-4 are rejected under 35 USC § 103(a) as being unpatentable over U. S. Patent No. 6,085,098 issued to Moon ("Moon") in view of U. S. Patent No. 5,523,754 issued to Eisen et al. ("Eisen"). Applicant traverses the foregoing rejections for the following reasons.

According to MPEP §2142 "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Further, according to MPEP §2143.03, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974))." "*All words in a claim must be considered in judging the patentability of that claim against the prior art.*" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), emphasis added.)

Applicant's claim 1 contains the limitations of "[a] method for providing a mobile terminal with a software keyboard proper for the language of a country where it is located in a mobile communications network providing global roaming, comprising the steps of: constructing a database on the information of multinational software keyboards in a server; transmitting the information on the location of the mobile terminal to the server; and transmitting the information on the proper software keyboard to the mobile terminal by ascertaining the country."

Applicant's claim 4 contains the limitations of "[a] recording medium programmed by a computer to perform a method for providing a mobile terminal with a software keyboard proper for the language of a country where it is located in a mobile communications network providing global roaming, the method comprising the steps of: constructing a database on the information of multinational software keyboards in a server; transmitting the information on the location of the mobile terminal to the server; and transmitting the information on the proper software keyboard to the mobile terminal by ascertaining the country."

In other words, Applicant's claimed invention relates to a method for providing a mobile terminal with a software keyboard that is proper for the language used in a country that it is located in within a mobile communications network providing global roaming, and a recording medium programmed by a computer to perform such method.

Moon provides an apparatus and method for automatically configuring settings for a software application in a portable intelligent communications device, where the software application settings are dependent on certain geographical location information.

Eisen provides an apparatus and a method for automatically remapping a keyboard input device of a computer system and allows the user to switch from application to application and input data using a different keyboard map without having to reset the entire system each time.

It is asserted in the Office Action that a combination of an apparatus and a method for automatically setting software application based on the geographical information by Moon and an apparatus and a method for automatically remapping a keyboard input device of a computer by Eisen is identical to Applicant's claimed invention. One can not jump to this conclusion without impermissible hindsight that because there is no direct motivation for combining methods for automatically setting calculator software including currency conversion and a language translator feature, and for automatically remapping a keyboard device of a computer.

According to MPEP 2142, [t]o reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the 'differences,' conduct the search and evaluate the 'subject matter as a whole' of the invention. The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." Applicant submits that without first reviewing Applicant's disclosure, no thought, whatsoever, would have been made to combine methods for automatically setting calculator software (including currency conversion and a language translator feature), and for automatically remapping a keyboard device of a computer.

Moreover, even if it were proper to combine the teachings of Moon with that of Eisen, the resulting invention would still not contain all of the limitations of Applicant's claims 1 and 4. Since neither Moon, Eisen, nor the combination of the two disclose, teach or suggest all the limitations contained in Applicant's claims 1 and 4, as listed above, there would not be any motivation to arrive at Applicant's claimed invention. Thus, Applicant's claims 1 and 4 are not obvious over Moon in view of Eisen since a

prima facie case of obviousness has not been met under MPEP §2142. Additionally, the claims that directly or indirectly depend from claim 1, namely claims 2-3, are also not obvious over Moon in view of Eisen for the same reason.

Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejections for claims 1-4 are respectfully requested.

CONCLUSION

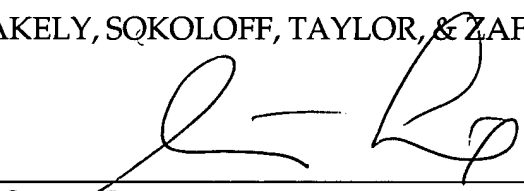
In view of the foregoing, it is submitted that claims 1-4 patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: June 9, 2004

By: 
Steven Laut, Reg. No. 47,736

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California
90025
(310) 207-3800

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail with sufficient postage in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P. O. Box 1450, Alexandria, Virginia 22313-1450 on June 9, 2004.


Jean Svoboda